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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,820	11/13/2001	William George Alton	287108-00001	5667
7590	11/04/2004			EXAMINER
David C. Jenkins Eckert Seamans Cherin & Mellott, LLC 44th Floor 600 Grant Street Pittsburgh, PA 15219			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	
DATE MAILED: 11/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/008,820	ALTON, WILLIAM GEORGE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason Prone	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,10,11,13 and 14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,8,9,12 and 15-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

1. In view of the appeal brief filed on 13 August 2004, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 5 line 20, item "18". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because on the page with Figure 6A, there are two Figures labeled as 6B. Therefore, the Figure furthest to the right show be re-labeled as "6C". Also, in Figure 3 the middle tooth, each outer side of the extension is labeled as "28". One of the sides should be re-labeled as "29". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The specification is objected to under 37 CFR 1.71, as being confusing and difficult to comprehend the invention and compare with prior art. For example, the following is not understood: It is unclear what structure makes cutting teeth "unset" cutting teeth. See the rejections under 35 USC § 112, first paragraph for more details. Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-5, 8, 9, 12, and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

On page 5 line 20, the term "unset teeth" is unclear. It is uncertain what structure allows a cutting tooth to be an "unset" cutting tooth. The term "unset" is defined as:

**un·set (ən-sĕt<sup>1</sup>) adjective**

1. Not yet firm or solidified: *unset gelatin; unset cement.*
2. Not mounted in a setting: *an unset gem.*<sup>1</sup>

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<sup>1</sup> *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from IHSN Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

From Figure 3, the teeth clearly look firm or solidified onto the band body, therefore it is uncertain how the teeth could be considered unset.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-5, 8, 9, 12, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 1, the term "unset teeth" is unclear. It is uncertain what structure makes cutting teeth "unset" cutting teeth. From Figure 3, that the cutting teeth appear to be "set" teeth due to the fact that they form a rigid structure with the band saw base.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Foerster.

Foerster discloses the same invention including a band saw body (1) having a centerline (Fig. 1), a plurality of unset teeth disposed on the band saw body (A), that each tooth has a body with two outer sides defining a width and a uniform height (Fig. 1), that at least some of the teeth have cutting extensions extending above the height of

the tooth body (10), that each cutting extension has two outer sides (Fig. 1), and that the two outer sides define the width of the extension (Fig. 1).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster in view of Kullman (4,640,172). Foerster discloses the invention including that the teeth are disposed on the band saw in groups (Fig. 1), that within each group the sum of the width of the cutting extensions is about equal to the width of the teeth bodies (10), that within a group each cutting extension outer side aligns with the outer side of the tooth body (10 and A), and that each cutting extension is about the same width (10) but fails to disclose that each tooth in a group has a cutting extension which does not have a portion of the extension aligned with another cutting extension in the group. '172 teaches that each tooth in a group has a cutting extension that does not have a portion of the extension substantially aligned with another cutting extension in the group (8 and 8'). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Foerster with un-aligned extension, as taught by '172, to allow for a wider cut.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster in view of '172 as applied to claims 1 and 2 above; and further in view of Kullman

(5,477,763). Foerster and '172 disclose the invention but fail to disclose that one group has a different number of teeth than another group. '763 teaches one group with a different number of teeth (2\*) than another group (2<sub>1</sub>). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Foerster in view of '172 with groups containing unequal amounts of teeth, as taught by '763, to allow for gradual cutting.

14. Claims 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster in view of '172 further in view of '763 as applied to claims 1, 2, and 15 above, and even further in view of Stoddard (5,606,900). Foerster, '172, and '763 disclose the invention including that within a group each cutting extension outer side aligns with the outer side of the tooth body (10 and A in Foerster), and that each cutting extension has about the same width (10 in Foerster) but fail to disclose that groups are separated by a raker tooth. '900 teaches groups (Fig. 2A-C) separated by a raker tooth (30). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Foerster in view of '172 further in view of '763 with a raker tooth, as taught by '900, to allow for gradual cutting.

***Allowable Subject Matter***

15. Claims 5, 8, 9, 12, and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments with respect to claims 1-4, 15-17, and 19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP  
October 22, 2004

  
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